

## **REMARKS**

### **I. Amendments**

By this amendment, claim 1 has been amended; and claims 5, 6, 22, 23 and 50 have been cancelled without prejudice to the filing of future continuing applications.

This amendment adds no new matter to the specification. Support for the amendment may be found at page 20, lines 25-36 *inter alia*.

No amendment of inventorship is necessitated by this amendment.

### **II. Discussion of the First Rejection under 35 U.S.C. Sec. 112, First Paragraph**

Claim 50 has been rejected under 35 U.S.C. Sec. 112, first paragraph for allegedly failing to comply with the written description requirement.

By this amendment Applicants have cancelled claim 50, thereby rendering the rejection moot.

Therefore Applicants respectfully request withdrawal of the first 35 U.S.C. Sec. 112, first paragraph rejection.

### **III. Discussion of the Second Rejection under 35 U.S.C. Sec. 112, First Paragraph**

Claims 1, 4, 5, 11, 22-27 and 50 have been rejected under 35 U.S.C. Sec. 112, first paragraph as allegedly lacking enablement. Applicants respectfully traverse the rejection.

As an initial matter, Applicants note that claim 25 is an independent claim, which Applicants assert is adequately enabled.

By this amendment, claim 1 has been modified to recite specific anorectants, as suggested by the Examiner on page 3 of the Office Action mailed December 5, 2005. Applicants submit that independent claim 1 as amended is adequately enabled. Claims 4, 11, 24, 26 and 27 depend upon claim 1, and therefore are adequately enabled by virtue of the amendment to the related independent claim.

Claims 5, 22, 23 and 50 have been cancelled.

Therefore Applicants respectfully request withdrawal of the second 35 U.S.C. Sec. 112, first paragraph rejection.

#### **IV. Discussion of the Rejection under 35 U.S.C. Sec. 112, Second Paragraph**

Claims 1, 4-6, 11-24, 26, 27 and 50 have been rejected under 35 U.S.C. Sec. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse the rejection.

As an initial matter, Applicants note that claims 12-21 are not currently pending and therefore were improperly rejected.

Applicants continue to assert that the objected-to phrase is sufficiently clear. However, to expedite prosecution, Applicants have modified independent claim 1 to substitute the word “and” for the objected-to phrase. Applicants respectfully submit that independent claim 1 as amended is sufficiently clear. Claims 4, 11, 24, 26 and 27 depend upon claim 1, and therefore are also sufficiently clear by virtue of the amendment to the related independent claim. Claims 5, 6, 22, 23 and 50 have been cancelled.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, second paragraph rejection.

#### **V. Discussion of the Rejection under 35 U.S.C. Sec. 103(a) over WO 98/11884 and Russell *et al.* (MEDLINE AN 97386874) in view of Biosis AN 1997:356824**

Claims 1, 4-6, 11-24, 26, 27 and 50 have been rejected under 35 U.S.C. Sec. 103(a) as allegedly being unpatentable over WO 98/11884 and Russell *et al.* (MEDLINE AN 97386874) in view of Biosis AN (1997: 356824). Applicants respectfully traverse the rejection.

As an initial matter, Applicants note that claims 12-21 are not currently pending and therefore were improperly rejected.

By this amendment, Applicants have modified independent claim 1 to recite specific anorectics. Applicants submit that claim 1 as amended is not obvious over the combined teaching of the cited references. Claims 5, 6, 22, 23 and 50 have been cancelled. Claims 4, 11,

24, 26 and 27 depend upon claim 1. Applicants assert that the more specific dependent claims are also not rendered obvious over the combined teaching of the cited references.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 103(a) rejection over WO 98/11884 and Russell *et al.* (MEDLINE AN 97386874) in view of Bosis AN (1997: 356824).

**VI. Discussion of the Rejection under 35 U.S.C. Sec. 103(a) over MEDLINE AN 1998152487 and WO 93/03724 in view of Bosis AN 1997:356824**

Claims 1, 4-6, 11-24, 26, 27 and 50 have been rejected under 35 U.S.C. Sec. 103(a) as allegedly being unpatentable over MEDLINE AN 1998152487 and WO 93/03724 in view of Bosis AN (1997: 356824). Applicants respectfully traverse the rejection.

As an initial matter, Applicants note that claims 12-21 are not currently pending and therefore were improperly rejected.

By this amendment, Applicants have modified independent claim 1 to recite specific anorectics. Applicants submit that claim 1 as amended is not obvious over the combined teaching of the cited references. Claims 5, 6, 22, 23 and 50 have been cancelled. Claims 4, 11, 24, 26 and 27 depend upon claim 1. Applicants assert that the more specific dependent claims are also not rendered obvious over the combined teaching of the cited references.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 103(a) rejection over MEDLINE AN 1998152487 and WO 93/03724 in view of Bosis AN (1997: 356824).

**VII. Discussion of the Rejection for Obviousness-Type Double Patenting**

Claims 1, 4-7, 11, 22-27 and 50 have been rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-19 of U.S. Patent No. 6,329,403 (Odaka *et al.*). Applicants respectfully traverse the rejection.

To expedite prosecution, a Terminal Disclaimer over the '403 patent accompanies this response. Therefore, Applicants respectfully request withdrawal of the rejection for obviousness-type double patenting.



### VIII. Conclusion

Reconsideration of the pending claims as amended is requested.

Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, she is respectfully requested to call Applicants' attorney at (847) 383-3391.

Respectfully submitted,

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